

Remarks/Argument

Obviousness Type Double Patenting

Claims 12-20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-28 of copending Application No. 10/269,903. Applicants submit herewith a Power of Attorney form for the undersigned as well as a Terminal Disclaimer. Applicants respectfully request withdrawal of the Examiner's provisional rejection.

Rejection under 35 USC §103(a)


Claims 12-16 and 18-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Howe et al. (5,458,785) in view of Benner and/or Tepic. Claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over Howe et al. (5,458,785) in view of Benner and/or Tepic in further view of Beinhaus. Applicants respectfully traverse.

Applicants respectfully request to amend claim 12 to recite "direct" binding of the DNA to the magnetizable particle. Howe does not provide such a teaching. Howe neither teaches nor suggests the binding of nucleic acid molecules directly to the particles. In contrast to the claims as amended, Howe teaches the use of "beads which are **coated** with a reagent to specifically bind with the polymer to be recovered." Column 4, lines 27-28 (emphasis added). The remainder of the rejected claims (claims 13-20) depend from claim 12. Neither Benner, Tepic nor Beinhaus cures this deficiency. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

Conclusion

The claims of the present application are believed to be in condition for allowance and early notice thereof is respectfully requested.

Respectfully submitted,



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